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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,665	10/20/2000	Herve Andrean	06028 0016	9090

7590

11/03/2004

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EXAMINER

ELHILO, EISA B

ART UNIT PAPER NUMBER

1751

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,665

Applicant(s)

ANDREAN ET AL.

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-100 is/are pending in the application.
- 4a) Of the above claim(s) 21-25, 30-37, 40, 41, 43, 54-55, 58-60, 65-72, 75, 76 and 78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20, 26, 27, 38, 42, 44-53, 56, 57, 61, 62, 73, 77 and 79-100 is/are rejected.
- 7) ☒ Claim(s) 28, 29, 39, 63, 64 and 74 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1 This action is responsive to the remarks filed on August 5, 2004.

2 Claims 21-25, 30-37, 40-41, 43, 54-55, 58-60, 65-72, 75-76 and 78 are withdrawn from consideration.

3 The rejection of claims 26-27 and 61-62 under 35 U.S.C. 112, 2d paragraph is maintained for the reasons set forth in the previous office action that mailed on April 05, 2004.

4 The rejection of claims 17-20, 38, 42, 44-53, 56-57, 73, 77 and 79-100 under 35 U.S.C. 103(a) is maintained for the reasons set forth in the previous office action that mailed on April 05, 2004.

5 Claims 28-29, 39, 63-64 and 74 objected to for the reasons set forth in the previous office action that mailed on April 05, 2004.

Response to Applicant's Arguments

6 Applicant's arguments filed 8/5/2004 have been fully considered but they are not persuasive.

Applicants argue that claim 78 was elected by the applicants for prosecution but withdrawn by the examiner as nonelected claim.

The examiner respectfully disagrees with the above argument because applicants elected formula (VIII) to be prosecuted and wherein the chemical compounds of benzoylacetonitrile, 5-amino-2H-pyrazol-3-ol, and 4-imino-4,5-dihydroxythiazol-2-ylamine as recited in claim 78 is not represent the elected claimed formula (VIII). Therefore, the claim is withdrawn as non-elected claim.

Applicants also argue that the status of claims 26, 27, 61 and 62 is unclear because the

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examiner rejected these claims under 35 U.S.C. 112, 2d paragraph, and also the claims are withdrawn from further consideration.

The examiner respectfully disagrees with the above argument because the examiner indicated clearly the claims that withdrawn from further consideration and these claims are 21-25, 30-37, 40-41, 54-55, 58-60, 64-72, 75-76 and 78 (see the previous office action, page 5, paragraph 6) and therefore, claims 26, 27, 61 and 62 are not among the above withdrawn claims.

The examiner position is that claims 26, 27, 61 and 62 recite pyridine derivatives and they should read on formula (VII), but the recited pyridine derivatives comprise a cyano radical as recited in the claims wherein in the formula (VII) non of R12, R13 and R14 represents a cyano group. This is why the claims are rejected under 112, 2d paragraph as indefinite due to insufficient antecedent basis for this limitation "cyano" in the claims.

Furthermore, claims 26, 27, 61 and 62 are nonelected by the applicants but according to the PCT Rule the examiner has extended the search to cover some of the nonelected species and not all the nonelected species, and since there is a prior art that can be used to reject one of the nonelected species, the rest of the nonelected species would not be searched.

The applicants further argue that claimed 29, which is indicated as allowable, is not included in the list of the elected claims.

The examiner position is that claim 29 recites species that read of the elected claimed formula (VIII), in which X is oxygen (includes furan radical) or nitrogen (includes indole radical) with a ketone at position 2.

The applicants further argue that claims 20, 38, 52 and 73 are listed neither as withdrawn not elected, yet both claims stand rejected.

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The examiner respectfully disagrees with the above argument because these claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenke (US' 014) in the previous office action that mailed on April 5, 2004 (see page 6), wherein the reference teaches 2,6-dihydroxypyridine as a heterocyclic ring comprising a nitrogen atom (claims 20 and 52) and aromatic benzaldehyde (claims 38 and 73). Therefore, the claimed are rejected under the prior art.

With respect to the applicants' request for considering allowing claims 64 and 78, the examiner's position is that claims 43 and 78 are withdrawn from further consideration for the reason given above, while claim 64 is considered allowable subject matter for the reasons set forth in the previous office action.

With respect to the rejection of the claims under 35 U.S.C. 103(a), Applicants argue that the difference between the Wenke's composition and the claimed formula (VII), is the difference between a hydrogen and the R12 substituent which is chosen from substituted or unsubstituted alkyl or substituted or unsubstituted aryl groups and R12 is not a hydrogen but at a minimum, a methyl (-CH₃).

The examiner respectfully disagrees with the above argument because it is well established that the substitution of methyl for hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. *In re Wood*, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and *In re Lohr*, 137 U.S.P.Q. 548, 549 (C.C. P.A. 1963). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (ie., an anti-thrombin). Therefore, the prima facie case of obviousness has been established.

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7 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

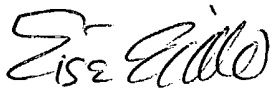
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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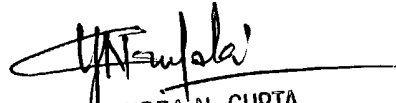
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Eisa Elhilo

October 20, 2004



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